

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: WILLIAM ALLOCCA *et al.*
APPLICATION No.: 09/547,540
FILED: APRIL 12, 2000
FOR: PLACING A PURCHASE ORDER USING
ONE OF MULTIPLE PROCUREMENT
OPTIONS

EXAMINER: YOGESH C. GARG
ART UNIT: 3625
CONF. NO: 5837

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Appellant submits this reply brief pursuant to 37 C.F.R. § 41.41. As discussed below, appellant respectfully disagrees with the Examiner's position that a delivery address is a procurement option. Also, although there is no suggestion or motivation in the prior art to combine Hartman and Yamada, if one skilled in the art tried to combine them, the result would be not be appellant's invention.

Hartman describes a single-action ordering system in which purchaser-specific order information (e.g., delivery information and payment information) is associated with a purchaser so that single-action ordering can be enabled. Hartman suggests that the purchaser-specific order information "collected when an order is placed conventionally [using a shopping cart]" can be saved for later use. (Hartman, 6:48-50.) When the purchaser places an order for an item using single-action ordering, that saved purchaser-specific order information can then be used to complete an order for an item. Hartman also describes a conventional shopping cart model in which items

that a purchaser wants to purchase are added to a shopping cart. When the purchaser wants to actually place the order (i.e., check out), the purchaser is prompted for purchaser-specific order information (e.g., billing and shipment information) and then the order is placed using that purchaser-specific order information. (Hartman, 2:17-48.) If the purchaser subsequently places an order using single-action ordering, then that order can also be placed using the purchaser-specific order information input when the previous order was placed using the shopping cart.

Yamada also describes a shopping cart model in which a user does not have to make a hierarchical re-selection of a delivery address or re-enter a delivery address. Yamada's shopping cart allows a purchaser to designate various delivery addresses to which an order can be shipped. When a purchaser places the order, the purchaser selects one of the designated delivery addresses as the delivery address for the order. Yamada delivers to certain predefined delivery locations (e.g., participating 24-hour convenience stores) and provides a hierarchical way to select a delivery location that includes selecting a state, a city, an area within city, and a participating store within the area. Because the hierarchical selection of a predefined delivery location is cumbersome, Yamada allows a purchaser to designate some of the predefined delivery locations along with other delivery locations (e.g., the purchaser's home) to where a purchased item should be delivered. When an order is placed, the purchaser can simply select from one of the designated delivery addresses without having to perform the hierarchical selection or re-enter some other address.

Claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68, and 129 recite "multiple procurement options" (or "multiple groups of order fulfillment information") in which each procurement option includes delivery information and payment information. The Examiner states that Yamada's "several pre-defined choices for delivery destination clearly corresponds to multiple pre-defined procurement options and satisfies the limitation recited in the independent claims 1, 10, and 29." (Examiner's Answer, p. 5.) Appellant respectfully submits that Yamada's delivery addresses are only delivery addresses and not procurement options that include both delivery information and

payment information. (Yamada, Fig. 9.) Delivery addresses are not procurement options as recited by appellant's claims because they do not include payment information.

In addition, several of appellant's claims (i.e., 10-27, 33-38, 50-55, and 129) recite that a procurement option has "information that is sufficient to complete an order for the identified item" or "for an item." Yamada's delivery addresses are, in contrast, not sufficient information to complete an order for an item. A user of Yamada's system would presumably need to somehow make payment to complete the order. Yamada does not, however, describe how payment could be made.

The Examiner is also impermissibly using appellant's specification as a template for piecing together Hartman and Yamada. First, neither Hartman nor Yamada suggests a way in which Hartman's single-action ordering can be combined with Yamada's shopping cart that has multiple delivery addresses. Since no other references are cited, it appears that the Examiner is relying on appellant's specification to piece together Hartman and Yamada.

Second, if one skilled in the art tried to combine Hartman and Yamada, the result would not be appellant's invention. Rather, the combination would have Yamada's shopping cart and Hartman's single-action ordering component. When a purchaser checks out the items currently in the shopping cart, the purchaser could select one of Yamada's designated delivery addresses (e.g., without re-entering the delivery information using a hierarchical selection). When a purchaser uses single-action ordering to place an order for an item, the single-action order can be placed using the same delivery information used by the purchaser when placing an order via the shopping cart as described in Hartman. This combination, however, would not have the multiple procurement options as recited by all of appellant's claims since delivery addresses by themselves are not procurement options as discussed above. In addition, this straightforward combination "would allow the user the novelty and the convenience to order items online for different destinations," which the Examiner believes is the motivating benefit for combining the references. (Examiner's Answer,

p.5.) Because the suggested motivating benefit is attained by such a straightforward combination, the Examiner has not demonstrated why one skilled in the art who wants to attain this benefit would eschew this straightforward combination in favor of any different combination, let alone a combination that would result in appellant's invention. Again, it appears that the Examiner is using appellant's specification as a template to piece together Harman and Yamada.

For the reasons stated in the Appeal Brief¹, the Supplemental Appeal Brief, and this Reply, appellant respectfully requests that the rejection of the claims be reversed.

Dated: 7-3-06

Respectfully submitted,

By Maurice J. Pirio
Maurice J. Pirio
Registration No.: 33,273
PERKINS COIE LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8548
(206) 359-9548 (fax)
Attorney for Applicant

¹ Appellant, however, withdraws the arguments in section IX.B.1 of the Appeal Brief.